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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/735,509

12/12/2003

Sudarshan Palliyil

JP920030270US1

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06/18/2009

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EXAMINER

TURCHEN, JAMES R

ART UNIT

PAPER NUMBER

2439

MAIL DATE

DELIVERY MODE

06/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* SUDARSHAN PALLIYIL, SHIVAKUMARA VENKAT  
SHAMURTHY, and TEJASVI ASWATHANARAYANA

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Application No. 10/735,509  
Technology Center 2400

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Mailed: June 18, 2009

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Before ERIC W. HAWTHORNE, *Supervisory Paralegal Specialist*  
HAWTHORNE, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on April 30, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

**APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER**

Appellant filed an Appeal Brief dated October 23, 2008. The Appeal Brief is not in compliance with 37 C.F.R. § 41.37(c) effective September 13, 2004.

According to 37 C.F.R. § 41.37(c)(v), an Appeal Brief must include the following:

(v) ***Summary Of Claimed Subject Matter***. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. [*emphasis added*].

The “Summary of Claimed Subject Matter” appearing on pages 3-8 of the Appeal Brief filed October 23, 2008 is deficient because it does not separately map independent claims 24, 31, 38 to the specification. It rather maps the independent claims to the published application which is not in compliance with 37 C.F.R. § 41.37(c)(v). Correction is required.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 C.F.R. 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 C.F.R. 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

**CONCLUSION**

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

1) hold the Appeal Brief filed October 23, 2008 defective, as required by 37 C.F.R. § 41.37(c)(1)(v);

2) notify the Appellant to submit a “paper” which corrects the Appeal Brief’s Summary of Claimed Subject Matter under 37 C.F.R. §41.37(c)(1)(v);

3) acknowledge and consider any “paper” submitted by Appellant to correct the Appeal Brief, and;

4) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

EWH/nhl

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